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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,084	10/27/2003	Benson D. McGann	100827.0005US2	4162
21611	7590	03/14/2005	EXAMINER	
SNELL & WILMER LLP 1920 MAIN STREET SUITE 1200 IRVINE, CA 92614-7230			MANAHAN, TODD E	
		ART UNIT	PAPER NUMBER	
			3732	

DATE MAILED: 03/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/695,084	MCGANN, BENSON D.	
	Examiner Todd E. Manahan	Art Unit 3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 21 December 2004.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 8-16 and 18-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 8-16, 18-20 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

## **DETAILED ACTION**

### *Claim Objections*

Claims 13-16 are objected to because of the following informalities: claims 13-16 have been amended, however the amended claims are not in accordance with 37 CFR 1.121. The examiner has corrected this problem. All future correspondence should identify these claims as (previously presented).

### *Claim Rejections - 35 USC § 101*

35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

Claim 20 is rejected under 35 U.S.C. § 101 because it appears to embrace more than one statutory class of invention. Claims which are intended to embrace both product or machine and process is precluded by language of 35 USC 101, which sets forth statutory classes of the invention in the alternative only. The preamble of claim 20 recites an automated system and thus appears to be directed to the apparatus, however the body of the claim recites purely method or process steps, and thus appear to be directed to a process. As such, claim 20 appears to embrace multiple statutory classes of invention which is prohibited (See *Ex parte Lyell*, 17 USPQ2d 1548 (1990)).

### *Claim Rejections - 35 USC § 112*

Claim 20 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 20 is invalid under 35 USC 112, second paragraph, since a claim which purports to be both machine and process is ambiguous and therefore does not particularly point out and

distinctly claim the subject matter of the invention. *Ex parte Lyell*, 17 USPQ2d 1548 (1990). As such, claim 20 has not been further treated on the merits thereof.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 8-16, 18 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Andreiko et al. (United States Patent No. 5,533,895).

Andreiko et al. disclose a system for selecting an archwire for a patient comprising a digital camera for scanning the teeth and therefore also the arch of a patient and a digital computer including data on a group of standardized archwires and a mechanism for selecting an archwire based upon comparison of the archwire data and the scanned data and ordering the archwire from the manufacturer.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8-16, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jordan et al. (United States Patent No. 6,089,868).

Jordan et al. discloses a system for automatically selecting orthodontic appliances essentially as claimed wherein the system includes data on available orthodontic appliances and the CPU selects the appropriate band based on comparison of the scanned data and the stored data of the orthodontic appliance. It would have been obvious to one skilled in the art to provide the system of Jordan et al. with data on available archwires as the orthodontic appliances in order to provide automatic selection of the archwire.

*Response to Arguments*

Applicant's arguments filed 21 December 2004 have been fully considered but they are not persuasive.

In response to applicant's arguments that neither Andreko nor Jordan disclose methods of obtaining and using a patient's PIAC, it is to be noted that the claims in the instant application are directed to an apparatus, not a process. Thus it is irrelevant whether the prior art shows a process which is not claimed.

In response to applicant's arguments that the prior art does not show an input mechanism "adapted to ...", it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138. Both Andreio and Jordan disclose mechanisms by which information can be input.

*Conclusion*

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Todd E. Manahan whose telephone number is 571 272- 4713. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on 571 273-4720. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Todd E. Manahan  
Primary Examiner  
Art Unit 3732